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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,961	10/20/2003	Yasushi Hattori	Q78028	8652
23373	7590	06/28/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			RICKMAN, HOLLY C	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,961

Applicant(s)

HATTORI ET AL.

Examiner

Holly Rickman

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 13-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 13-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/12, 2/27, 4/27 all 2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure fails to provide written description or support for the newly added limitations requiring that the ferromagnetic ordered alloy particles have “substantially spherical shape.”

Applicant argues that the specification provides inherent support for this recitation because the reverse micelle method necessarily produces substantially spherical particles. There is no *evidence* of record to support this position.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1773

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2002-157727 (see Japanese document and English translation).

JP 2002-157727 discloses a magnetic recording medium having a magnetic layer formed from magnetic particles formed from CuAu or Cu₃Au materials such as FePt (paragraph 11 of Japanese document discloses these materials for magnetic particles). Suitable binder resins include silicone resin (see para 21). The reference teaches the use of various substrate materials including resin materials which satisfy the claim limitations directed to a “heat-resistant support.”

It is noted that the preamble limitations of the claims 21-22 have been considered. However, they are essentially recitations of intended use and do not patentably distinguish the claimed structure over that shown in the prior art.

5. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Litvinov et al. (US 6884328).

See Fig 3, col. 2, line 45 to col. 3, line 62.

Claim Rejections - 35 USC § 102/103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13-15, 25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2002-157727 (see Japanese document and English translation).

JP 2002-157727 discloses a magnetic recording medium having a magnetic layer formed from magnetic particles formed from CuAu or Cu₃Au materials such as FePt and CoPt (paragraph 11 of Japanese document discloses these materials for magnetic particles). Suitable binder resins include silicone resin (see para 21). The reference teaches the use of various substrate materials including resin materials.

JP 2002-157727 is silent with regard to forming the disclosed particles by a reverse micelle method. However, this is a process limitation in an article claim. There is no *evidence* of record to establish that use of the claimed method results in a *materially different* product. When there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show the same process of making. In re Brown, 173 USPQ 685 and In re Fessmann, 180 USPQ 324. Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does

Art Unit: 1773

not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

It is noted that the preamble limitations of the claims 14-15 have been considered. However, they are essentially recitations of intended use and do not patentably distinguish the claimed structure over that shown in the prior art.

Claim Rejections - 35 USC § 103

8. Claims 16-18, 23-24, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-157727 (see Japanese document and English translation) and further in view of Onodera et al. US 6696183.

JP 2002-157727 discloses a magnetic recording medium having a magnetic layer formed from magnetic particles formed from CuAu or Cu₃Au materials such as Co₃Pt, FePt, and CoPt (paragraph 11 of Japanese document discloses these materials for magnetic particles). Suitable binder resins include silicone resin (see para 21). The reference teaches the use of various substrate materials including resin materials.

JP 2002-157727 appears to be silent with regard to the use of a protective layer. Onodera et al teaches that it is conventional in the art to add a protective layer to the surface of a binder-type magnetic tape in order to protect the magnetic surface (col. 11-16).

Art Unit: 1773

It would have been obvious to one of ordinary skill in the art at the time of invention to add a protective layer to the magnetic structure taught by JP 2002-157727 in order to reduce wear on the surface of the recording medium.

It is noted that the preamble limitations of claims 17-18 have been considered. However, they are essentially recitations of intended use and do not patentably distinguish the claimed structure over that shown in the prior art.

Response to Arguments

9. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1773

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Holly Rickman", with a stylized flourish at the end.

Holly Rickman
Primary Examiner
Art Unit 1773